

DOCKET NO.: ISIS-3455



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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TECH CENTER 1600/2800

In re application of:

Cowsert, Baker, McNeil, Freier, Sasmor, Brooks, Ohashi, Wyatt, Borchers and Vickers

Serial No.: 09/295,463

Group Art Unit: 1631


Filed: April 13, 1999

Examiner: A. Marschel

For: **IDENTIFICATION OF GENETIC TARGETS FOR MODULATION BY
OLIGONUCLEOTIDES AND GENERATION OF OLIGONUCLEOTIDES
FOR GENE MODULATION**

I, Paul K. Legaard, Registration No. 38,534 certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

On October 30, 2000


Paul K. Legaard Reg. No. 38,534

Assistant Commissioner for
Patents
Washington, D.C. 20231

Dear Sir:

RESPONSE TO THE RESTRICTION REQUIREMENT

The present Response is filed in regard to the Restriction Requirement mailed September 28, 2000 in connection with the above-identified patent application.

The Examiner has restricted claims 1-54 into two groups. According to the Examiner, group I contains claims 1, 2, 5, 21, 22, 25 and 41-46 and is drawn to computer products and methods of defining a set of compounds that modulate the expression of a target nucleic acid sequence via defined criteria *in silico* without requiring physical synthesis or physical assay for biological effects. Group II, according to the Examiner, contains claims 3, 4, 6-20, 23, 24, 26-40 and 47-54 and is drawn to computer products and methods of defining a set of compounds that modulate the expression of a target nucleic acid sequence via defined criteria *in silico* and requiring physical

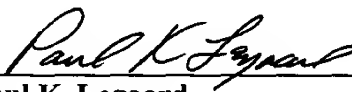
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synthesis or physical assay for biological effects. Applicants elect herein group II containing claims 3, 4, 6-20, 23, 24, 26-40 and 47-54.

Applicants submit that the present response is complete and complies with the requirements of 35 U.S.C. §121.

Respectfully submitted,



Paul K. Legaard

Registration No. 38,534

Date: **October 30, 2000**

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1631

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In Re Application of:

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Brooks, Ohashi, Wyatt, Borchers and
Vickers

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For: IDENTIFICATION OF GENETIC TARGETS FOR MODULATION BY
OLIGONUCLEOTIDES AND GENERATION OF OLIGONUCLEOTIDES FOR
GENE MODULATION

DATE OF DEPOSIT: 30 OCTOBER 2000

I HEREBY CERTIFY THAT THIS PAPER IS BEING
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Paul Legaard
Paul Legaard
REGISTRATION NO.: 38,534

Box ☒ NON-FEE
☐ AF

Assistant Commissioner for Patents
Washington DC 20231

Sir:

AMENDMENT TRANSMITTAL LETTER

Transmitted herewith for filing in the above-identified patent application is:

- ☐ A Preliminary Amendment.
- ☒ An Amendment Responsive to the Office Action Dated September 28, 2000.
- ☐ An Amendment Supplemental to the Paper filed _____

- ☐ Other: _____
- ☒ Small entity status of this application under 37 C.F.R. 1.9 and 1.27 was established in a previous submission.
- ☐ A Statement Claiming Small Entity Status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- ☐ This application is no longer entitled to small entity status. It is requested that this be noted in the files of the Patent and Trademark Office.
- ☐ Substitute Pages _____ of the Specification are enclosed.
- ☐ An Abstract is enclosed.
- ☐ _____ Sheets of Proposed Corrected Drawings are enclosed.
- ☐ A Certified Copy of each of the following applications: _____
_____ is enclosed.
- ☐ An Associate Power of Attorney is enclosed.
- ☐ Information Disclosure Statement.
- ☐ Attached Form 1449.
- ☐ A copy of each reference as listed on the attached Form PTO-1449 is enclosed herewith.
- ☐ Appended Material as follows: _____
- ☐ Other Material as follows: _____

FEE CALCULATION

☒ No Additional Fee is Due.

				SMALL ENTITY		NOT SMALL ENTITY	
	REMAINING AFTER AMENDMENT	HIGHEST PAID FOR	EXTRA	RATE	FEE	RATE	FEE
TOTAL CLAIMS	111	111 (20 MINIMUM)	0	\$9 EACH	\$0	\$18 EACH	\$
INDEP. CLAIMS	45	45 (3 MINIMUM)	0	\$40 EACH	\$0	\$80 EACH	\$
FIRST PRESENTATION OF MULTIPLE DEPENDENT				\$135	\$	\$270	\$
<input type="checkbox"/> ONE MONTH EXTENSION OF TIME				\$55	\$	\$110	\$
<input type="checkbox"/> TWO MONTH EXTENSION OF TIME				\$195	\$	\$390	\$
<input type="checkbox"/> THREE MONTH EXTENSION OF TIME				\$445	\$	\$890	\$
<input type="checkbox"/> FOUR MONTH EXTENSION OF TIME				\$690	\$	\$1390	\$
<input type="checkbox"/> FIVE MONTH EXTENSION OF TIME				\$945	\$	\$1890	\$
<input type="checkbox"/> LESS ANY EXTENSION FEE ALREADY PAID				minus	(\$)	minus	(\$)
<input type="checkbox"/> TERMINAL DISCLAIMER				\$55	\$	\$110	\$
<input type="checkbox"/> OTHER FEE OR SURCHARGE AS FOLLOWS:							
TOTAL FEE DUE					\$0		\$

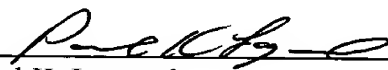
- ☐ A Check is Enclosed in the Foregoing Amount Due.
- ☐ Petition is hereby made under 37 C.F.R. 1.136(a) to extend the time for response to the Office Action of @@ to and through @@ comprising an extension of the shortened statutory period of @@ month(s).
- ☒ The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is

further authorized to charge any fees related to any such extension of time to deposit account 23-3050. This sheet is provided in duplicate.

- ☒ The Commissioner is authorized to charge payment of the following fees and to refund any overpayment associated with this communication or during the pendency of this application to deposit account 23-3050. This sheet is provided in duplicate.
- ☐ The Foregoing Amount Due for Filing this Paper.
- ☒ Any additional filing fees required, including fees for the presentation of extra claims under 37 C.F.R. 1.16.
- ☒ Any additional patent application processing fees under 37 C.F.R. 1.17 or 1.20(d).

SHOULD ANY DEFICIENCIES APPEAR with respect to this application, including deficiencies in payment of fees, missing parts of the application or otherwise, the United States Patent and Trademark Office is respectfully requested to promptly notify the undersigned.

Date: *30 OCTOBER 2000*


Paul K. Legaard
Registration No. 38,534

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